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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/129,298 08/05/98 ARNTZEN C 7991-023-999

KIMERAGEN INC
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HM12/0712

EXAMINER

ZAGHMOUT, O

ART UNIT

PAPER NUMBER

1649

DATE MAILED:

07/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/129,298

Applicant(s)
Arntzen et al.

Examiner
Ousama Zaghmout

Group Art Unit
1649

☒ Responsive to communication(s) filed on Aug 5, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-72 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-72 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1649

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-4, 8-30, 50-53 are drawn to a method of making localized mutation in a target gene, classified in class 435, subclass 238.

Group II. Claims 5-7 are drawn to a method for making mutation using RNA segment contains at least 8 contiguous 2'-substituted Ribonucleotides, classified in class 435, subclass 69.1.

Group III. Claims 31-49 are drawn to a method of making localized, non-selectable mutation in a target gene, classified in class 435, subclass 172.1.

Group IV. Claims 54-72 are drawn to a method of making specific mutation such as point mutation or frameshift mutation, classified in class 435, subclass 440.

2. The inventions are distinct, each from the other because of the following reasons:

a. Each invention is drawn to a molecularly and a biochemically divergent products and processes not required by the other.

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b. The invention of group I is drawn to a method of making localized mutation in a target gene which does not require the invention of group II which is drawn to a method for making mutation using RNA segment contains at least 8 contiguous 2'-substituted Ribonucleotides, other than the ones claimed in group 1 and it does not require the particular DNA molecules of group 1, not required by the invention of group III which is drawn to a method of making localized, non-selectable mutation in a target gene and the use of slectable marker of group I is not required by the invention of group III, not required by the invention of group IV which is drawn to a method of making point or frameshift mutation which is required by the invention of group I because it is drawn to a random rather than a specific mutation. Likewise, the invention in each of the other groups is independent and patentability distinct for the same reasons mentioned above. Clearly, they are independent since you could practice one invention without practicing or infringing any of the others. Similarly, each is patentability distinct since they constitute different products which can each support its own patent.

As such, the invention in each one of these groups require separate search and it be burden on the Examiner to examine more than one invention in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently amendment of inventorship must be accompanied by a diligently-filled petition under 37 CFR 1.148(b) and the fee required under 37 CFR 1.17(h).

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.
July 5, 1999


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600